

REMARKS

Claims 1-21 are pending in the application. Claims 17-21 are withdrawn from consideration. Claims 1-16 are rejected. Claims 2, 3, and 14 are hereby amended.

Restriction Requirement

I. Claims 1-16 are said to be drawn to a foamed pressure sensitive adhesive article, classified in class 428, subclass 343;

II. Claims 17-18 are said to be drawn to a multi-layered article, classified in class 428, subclass 304.4; and

III. Claims 19-21 are said to be drawn to method of forming a foamed pressure sensitive adhesive article, classified in class 156, subclass 60+.

Applicants affirm their election of Group I (i.e., claims 1-16) with traverse, and respectfully request reconsideration and withdrawal or modification of the restriction requirement.

The restriction requirement states:

"Inventions Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as insulation tape and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions Group III and Group I are related as process of making and product made. The

claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different product, such as a thermal insulation tape.

Inventions Group III and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by coextrusion process."

Applicants submit that notwithstanding the differences between the Groups of claims, the inventions are so interrelated that a search of one group of claims will reveal art to the other. Further, the classification of Groups I, II, and III claims in different classes and subclasses is not sufficient grounds to require restriction, especially as to Groups I and II, which are in the same class.

Were restriction to be effected between the claims in Groups I, II, and III, a separate examination of the claims in each Group would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups I, II and III would have to be as rigorous as when only the claims of Group I were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicants submit that for restriction to be effected between the claims in Groups I, II, and III, it would place an undue burden on Applicants' assignee by requiring payment of a separate filing fee for examination of the nonelected claims, as well as the added costs associated with prosecuting three applications and maintaining three patents.

Rejections

§ 112 Rejection, Second Paragraph

Claim 14 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for

Applicants have amended claim 14 as suggested by the Examiner.

Applicants have also amended claims 2 and 3 as suggested by the Examiner.

Based on the foregoing, Applicant(s) submit that the rejection under 35 U.S.C. § 112, second paragraph should be withdrawn.

35 U.S.C. 103(a) - Gehlsen (U.S. 6,103,152)

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehlsen.

The Office Action essentially states:

Gehlsen's invention is directed to polymer foam articles (Abstract). Gehlsen teaches that articles incorporating polymer foam are known. The foam includes a polymer matrix and is characterized by a density that is lower than the density of the polymer matrix itself. Density reduction is achieved in a number of ways, including through creation of gas-filled voids in the matrix (e.g., by means of a blowing agent) or inclusion of polymeric or non-polymeric microspheres (e.g., glass microspheres).

For claims 1-4, Gehlsen teaches that the various polymers are useful as the polymer matrix of the foam, such as polyphenylene oxide alloys, block copolymers of styrene and dienes, and block copolymer based adhesive. In Examples 23 and 50-53, styrene-isoprene-styrene and styrene-ethylene-butylene-styrene block copolymers are used as the polymer matrices.

With respect to claims 5-8 and 15, Gehlsen is silent on whether or not the styrenic block copolymer comprises a polymodal asymmetric block copolymer, and also that the polyarylene oxide has a softening temperature of at least 110°C and comprises polyphenylene ether and/or poly(2,6-dimethyl-1,4-phenylene ether). However, it is believed that these are recognized equivalents in the art, and the selection of any of these equivalents for forming foamed polymer matrices would be within the level of ordinary skill in the art.

With respect to claims 9-10 and 14, Gehlsen teaches that the foam may contain agents in addition to microspheres. Examples of suitable agents include those selected from the group consisting of tackifiers, plasticizers, etc. The foam may also include gas-filled voids in the polymer matrix. Such voids typically are formed by including a blowing agent in the polymer matrix or by exposing the polymer matrix to a gas.

With respect to claim 11, the Applicant argues that Gehlsen does not disclose the specific content and the peel strength of the adhesive article, the ASTM test results, in the absence of

unexpected results, these physical properties are each believed to be either inherently disclosed, or an obvious optimization to one of ordinary skill."

According to MPEP 2142, to establish a case of *prima facie* obviousness, three basic criteria must be met: 1) there must be some suggestion or motivation, either in the references or generally known to one of skill in the art, to modify or combine the reference teachings, 2) there must be reasonable expectation of success, and 3) the prior art references must teach or suggest all the claim limitations. The ability to modify the method of the references is not sufficient. The reference(s) must provide a motivation or reason for making the changes. *Ex parte Chicago Rawhide Manufacturing Co.*, 226 USPQ 438 (PTO Bd. App. 1984).

Applicants respectfully submit that the references cannot support a case of *prima facie* obviousness as to the claims because, among other possible reasons, the cited references do not provide a motivation or suggestion to use the combination of at least one styrenic block copolymer and at least one polyarylene oxide polymer as the polymer matrix for a pressure sensitive adhesive article. Although Gehlsen discloses polyphenylene oxide alloys in one class of materials that can be used in the polymer matrix of a foam and block copolymers of styrene and dienes in another class of materials that can be used in the polymer matrix of a foam, Gehlsen provides no suggestion or motivation to combine these two particular materials from the long list of possible matrix materials.

As stated in *In re Lemin*, 141 USPQ 814, 815, 816 (CCPA 1964), There is nothing obvious in choosing "some" among "many" indiscriminately. However, obviousness is overcome by showing that the choice is based on a discovery that some compounds, falling within a prior art genus, have a special significance, particularly where there is nothing in the prior art to suggest the established criticality of the "some."

As explained in the specification at p. 7, line 26 to p. 8, line 2, the polyarylene oxide polymer is miscible with the styrenic blocks of the copolymer and serves to raise the T_g of the mixture above that of the styrenic copolymer without the polyarylene oxide. This increase in T_g results in an increase in the cohesive strength of the blend, as shown in Example 1 of the specification.

In view of these facts, applicants submit that the cited references do not support a prima facie rejection of the claimed invention and request that the rejection be withdrawn.

In addition to the foregoing arguments, Applicants submit that a dependent claim should be considered allowable when its parent claim is allowed. *In re McCain*, 101 USPQ 411 (CCPA 1954). Accordingly, provided the independent claims are allowed, all claims depending therefrom should also be allowed.

Based on the foregoing, it is submitted that the application is in condition for allowance. Withdrawal of the rejections under 35 USC 102(b) and 103(a) is requested. Examination and reconsideration of the claims are requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicants' attorney if the Examiner believes any remaining questions or issues could be resolved.

Respectfully submitted,

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Date

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Version with markings to show amendments made:

2. (once amended) The foamed pressure sensitive adhesive article of claim 1, wherein the styrenic block copolymer [includes] comprises a diene copolymer.

3. (once amended) The foamed pressure sensitive adhesive article of claim 1, wherein the styrenic block copolymer [includes] comprises an isoprene copolymer.

14. (once amended) The foamed pressure sensitive adhesive article of claim 13, further comprising voids formed in the foamed pressure sensitive adhesive polymer by expanded microspheres.